

REMARKS

In the present application, claims 1-21 are pending. All claims were rejected in the Office Action. Applicants are amending claims 1, 20, and 21 to more clearly distinguish the present invention. In view of the forgoing amendments and the following remarks, Applicants respectfully request reconsideration of the application.

Double Patenting Rejection

In paragraph 2 of the Office Action, the Examiner rejected claims 1-21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,705,945. In response, Applicants are submitting a terminal disclaimer over U.S. Patent No. 6,705,945.

Rejection Under 35 U.S.C. §102

In paragraph 3, the Examiner rejected claims 1-4, 10, 12-14, and 18-21 as being anticipated by *Miyamoto* (USPN 6,296,570). Applicants respectfully traverse.

Amended claim 1 now reads in part “presenting game information to the user based on the state of the character, the game information being presented within a context of the game environment *without using indicators extraneous to the game environment*” (emphasis added). In describing background art to the present invention, Applicants disclose that onscreen indicators for providing information to a user, such as arrows, are extraneous to a game environment, and may clutter the screen, distract the user, or obstruct a user’s views and perspectives in the game environment. (see paragraph [0003] – [0004]). Thus, the

present invention provides game information without these extraneous indicators.

In contrast, *Miyamoto* provides a video game system which provides messages or indicators to the player to let the player know an appropriate action or convey information. These messages are provided by way of a display box on the display (see display box 85 of Fig. 10; and display boxes 31a, 31b, and 31d of Fig. 12) or as added visual information not pertaining to the action within the game environment (see score display area 31c of Fig. 12). In fact, *Miyamoto* actually teaches away from the present invention in that the present invention provides game information without extraneous indicators, such as the display boxes and score area. Therefore, claim 1 is not anticipated by *Miyamoto*. Additionally, because claims 2-4 depend from claim 1, claims 2-4 are not anticipated for the same reasons as that provided for claim 1.

With regards to claim 10, the claim recites in part, “provide information to a user by *modifying a character* in a game environment” (emphasis added). That is, the character will display some physical change which will provide the information to the user. In contrast, *Miyamoto* does not disclose modifying the character in order to provide information. Instead, *Miyamoto* only provides information via display boxes and areas on the screen (e.g., score area 31c, life box 31d, etc.). Therefore, *Miyamoto* does not anticipate claim 10. Furthermore, because claims 12-14 and 18-19 depend from claim 10, these claims are not anticipated for the same reason as that of claim 10.

Claims 20 and 21 have been amended to contain the “without using indicators extraneous to the game environment” limitation. As such, claims 20 and 21 are not anticipated for the same reasons as claim 1.

Rejection Under 35 U.S.C. §103

In paragraph 4a, the Examiner rejected claims 5-6 and 15-16 as being unpatentable over *Miyamoto* in view of *Yamada* (USPN 6,319,121). In particular, the Examiner found that *Yamada* “teaches a video game capable of presenting visual information (hit mark) to the user as a modification of the character.”

As noted by the Examiner, *Yamada* provides hit marks as visual information that the character has been hit. These hit marks, however, are extraneous to the game environment as they are essentially display boxes/areas with words that are placed over the character. Thus, the hit marks do not modify or change the character, itself, in any form or manner.

Furthermore, *Yamada* actually teaches away from the present invention in that the present invention provides game information without extraneous indicators, such as the hit mark. Therefore, claims 5-6 and 15-16 are not obvious in view of *Miyamoto* and *Yamada*.

In paragraph 4b, the Examiner rejected claims 7-9 and 17 as being unpatentable over *Miyamoto* in view of *Best* (USPN 5,393,073). Applicants traverse. *Best* provides a game system wherein a player has to react or respond to an audio input from a second character. For example the second character may ask a question, and the game will not proceed until the first player provides a response. The “game information” provided by the second character in *Best* is not based on the state of the first character, but is information provided to provoke or cause a next action by the first character. Furthermore, *Best* does not cure the deficiencies of *Miyamoto*. Therefore, claims 7-9 and 17 are not obvious in view of *Miyamoto* and *Best*.

In paragraph 4c, the Examiner rejected claim 11 as being unpatentable over *Miyamoto* in view of *Schwartz* (USPN 5,607,356). With respect to *Schwartz*, it does not cure the deficiencies of *Miyamoto*. That is, neither *Miyamoto* nor *Schwartz* provides a system where visual information is provided by modifying a character in the game environment. Additionally, the portion of *Schwartz* cited by the Examiner does not involve "statements between characters in the game environment," but merely utterances of the single character. Therefore, claim 11 is not obvious in view of *Miyamoto* and *Schwartz*.

Conclusion

Based on the foregoing amendments and remarks, Applicants believe the rejections in the Office Action of December 30, 2004 are fully overcome, and that the application is in condition for allowance. If the Examiner has questions regarding the case, the Examiner is invited to contact Applicants' undersigned representative at the number given below.

Respectfully submitted,
Andrew Gavin et al.

March 10, 2005

By:


Susan Yee (Reg. No. 41,388)
Carr & Ferrell LLP
2200 Geng Road
Palo Alto, CA 94303
TEL: (650) 812-3400
FAX: (650) 812-3444